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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/126,945	07/31/1998	TOWIA ARON LIBERMANN	1488-1090000	9528

7590 10/10/2002
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EXAMINER

PRIEBE, SCOTT DAVID

ART UNIT PAPER NUMBER

1632

DATE MAILED 10/10/2002

45

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/126,945

Applicant(s)

Libermann et al.

Examiner

Scott D. Priebe, Ph.D.

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 23, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 157, 159, 160, 162, 163, 165, 166, 168-173, 175, 176, 179, 180 is/are pending in the application. ^{182, 183, 184, 186, 187, 188, 228, 230, 232-242, 244, 250, 252-257}
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed. ^{153, 164, 166, 168, 169, 170, 171, 229, 231, 243, 245, 251, 253-256}
- 6) ☒ Claim(s) 157, 159, 160, 162, 163, 165, 166, 168-173, 175, 176, 179, 180, 182 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 38 & 42
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6) ☐ Other:

Art Unit: 1632

DETAILED ACTION

The finality of the Office action of 1/23/02 is withdrawn in view of the new grounds of rejection necessitated by newly found prior art, as set forth below. All prior indication of allowability of claims is withdrawn. The amendment filed 9/23/02 has been entered. Claims 158, 161, 164, 167, 174, 177, 178, 181, 184, 187, 190, 229, 231, 248, 251, and 288-294 have been cancelled. Claims 157, 159, 160, 162, 163, 165, 166, 168-173, 175, 176, 179, 180, 182, 183, 185, 186, 188, 189, 191-228, 230, 232-247, 249, 250, and 252-287 are pending and all are rejected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Unit: 1632

Claims 157, 159, 160, 162, 163, 165, 166, 168-173, 175, 176, 179, 180, 182, 183, 185, 186, 188, 189, 191-228, 230, 232-247, 249, 250, and 252-287 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Bandman et al., US 6,265,565.

Bandman et al. discloses a polynucleotide comprising a nucleic acid (nucleotides 15-1901 of SEQ ID NO: 2) which differs from nucleotides 1-1887 of instant SEQ ID NO: 1 by a single nucleotide substitution at nucleotide 1610 of instant SEQ ID NO: 1. The nucleic acid encodes a polypeptide (SEQ ID NO: 1), named prostate associated Ets protein (PRAEP), which is 100% identical to instant SEQ ID NO: 2. The reference teaches expression vectors comprising the polynucleotide and polynucleotides further comprising heterologous sequences, including operably linked heterologous sequences for control of transcription and translation, such as enhancers, promoters, Kozak sequences, etc. The reference teaches cells comprising the polynucleotide and methods of making the polypeptide from cultured cells comprising the expression vectors. The reference also teaches fusing the nucleic acid in-frame to heterologous coding sequence yielding a nucleic acid encoding a fusion polypeptide. See entire reference, especially at col. 15-16, 18-19, 39-44, 47 and 48.

Certain papers related to this application may be submitted to Art Unit 1632 by facsimile transmission. The FAX numbers are (703) 308-4242 or (703) 305-3014 for any type of communication. In addition, FAX numbers for a computer server system using RightFAX are also available for communications before final rejection, (703) 872-9306, and for communications after final rejection, (703) 872-9307, which will generate a return receipt. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If

Art Unit: 1632

applicant *does* submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott D. Priebe whose telephone number is (703) 308-7310. The examiner can normally be reached on Monday through Friday from 8 AM to 4 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached on (703) 305-4051.

Any inquiry concerning administrative, procedural or formal matters relating to this application should be directed to Patent Analyst Patsy Zimmerman whose telephone number is (703) 308-8338. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Scott D. Priebe

Scott D. Priebe, Ph.D.
Primary Examiner
Technology Center 1600
Art Unit 1632